

## REMARKS

In the Office Action mailed by the United States Patent and Trademark Office on May 21, 2008, claim 12 was rejected under 35 U.S.C. 112, first and second paragraph; claims 1, 7-8, 11-12, 22 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 to Kondo et al in view of Elkins (Hawaiian Noni, 1998) in further view of Vatter et al (6,224,888); and claims 1, 7-8, 11-12, 22 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over JP2000-095663 to Kondo et al in view of Wadsworth et al (WO 01115537) in view of Fisher (Living Better, vol. 1 (5)) in further view of Vatter et al (6,224,888).

### Claim Rejections Under 35 U.S.C. § 112

The limitation for “present in an amount between about 5-20 percent by weight” has been deleted from Claim 1. Accordingly, Applicant respectfully requests the withdrawal of the § 112 rejections.

### Claim Rejections Under 35 U.S.C. § 103

M.P.E.P. § 2141 sets forth the *Graham* factual inquiries that should be considered when making an obviousness rejection under Section 103: 1) ascertaining the scope and content of the prior art; 2) ascertaining the differences between the claimed invention and the prior art; and 3) resolving the level of ordinary skill in the pertinent art. (Citing *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).) In addition, M.P.E.P. §§ 2141 and 2142 set forth that “the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.” (Citing *KSR International Co. v. Teleflex Inc.* (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).)

The M.P.E.P. provides several examples of rationales that can support a rejection under 35 U.S.C. § 103, namely:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “Obvious to try” - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

(M.P.E.P. §§ 2141 & 2143, emphasis added.) As may be seen from the emphasized portions of the above potential rationales, each rationale is dependent on showing known elements from the prior art corresponding to the limitations of the claimed invention. Each rationale therefore depends on: 1) satisfying the *Graham* inquiry, showing that the scope and content of the prior art included each limitation contained in the claimed invention, and 2) satisfactorily showing that one of ordinary skill in the art would take the art teachings to overcome the identified differences under *Graham* between the claimed invention and the individual teachings of the prior art.

Applicant respectfully submits that the references in the Office Action, either alone or in combination, do not teach or suggest all the limitations claimed in the claim set provided herein. As indicated above in the amended claim section, independent claim 1 is directed toward a composition for topical application to provide lip care comprising: oxybenzone present in an amount between about 1-5 % by weight; castor oil; candelilla wax; sorbitan oleate; butyospermum parkii; macadamia seed oil; ozokerite; and Morinda citrifolia seed oil present in an amount between about 0.1-20 percent by weight. The cited art, either alone or in combination, does not teach or suggest the claimed combination of *Morinda citrifolia* seed oil, oxybenzone, castor oil, candelilla wax, sorbitan oleate, butyospermum parkii, macadamia seed oil and in the claimed ranges.

Applicant also respectfully submits that the Office Action has failed to show how one of skill in the art would have found it obvious to overcome the differences between the prior art and the claimed invention to arrive at the claimed invention. The claimed combination is not directly taught in the art, there is no suggestion in the cited art to combine and modify the references and one skilled in the art would not have been motivated to produce the claimed formulation. Accordingly, Applicant respectfully submits that for at least the reasons provided herein, the claims set as provided herein overcomes all rejections made by the Examiner in the Office Action.


### CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 20 day of August, 2007.

Respectfully submitted,

KIRTON & McCONKIE



Michael E. Krieger  
Reg. No. 35,232

Kirton & McConkie  
1800 Eagle Gate Tower  
60 East South Temple  
Salt Lake City, Utah 84111  
Telephone: (801) 321-4814  
Fax: (801) 321-4893

JRM/brc  
Doc#1083230